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PTO/SB/21 (08-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Application Number	08/479,920
Filing Date	June 7, 1995
First Named Inventor	Marcus F. Boehm
Group Art Unit	1621
Examiner Name	Paul J. Killos
Attorney Docket Number	45026.00065.CON1

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**OFFICE OF PETITIONS**

Total Number of Pages in This Submission

14

**ENCLOSURES (check all that apply)**☒ Fee Transmittal Form☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/ Incomplete Application☐ Response to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☒ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ After Allowance Communication to Group☐ Appeal Communication to Board of Appeals and Interferences☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☐ Other Enclosure(s) (please identify below):

Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181 dated 1/6/04; copy of Petition Pursuant to 37 CFR § 1.313(a) to Withdraw Application from Issuance dated 10/14/98; copy of Examiner Interview Summary Record; and copy of Amendment and Remarks dated 8/10/99.

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

36183

PATENT TRADEMARK OFFICE

Firm or Individual name

Paul, Hastings, Janofsky &amp; Walker LLP

Signature

Jane K. Babin, Ph.D., Esq. Reg. No. 47,224

Date

January 6, 2004

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

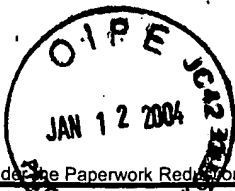
Typed or printed name

Janice Crisp

Signature

Date

January 6, 2004



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PTO/SB/17 (10-03)

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## FEE TRANSMITTAL

for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 130.00)

## Complete if Known

Application Number	08/479,920
Filing Date	June 7, 1995
First Named Inventor	Marcus F. Boehm
Examiner Name	Paul J. Killos
Art Unit	1621
Attorney Docket No.	45026.00065.CON1

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## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

Deposit Account Number 50-2613

Deposit Account Name

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)				(\$ 0)	

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid	
Total Claims		-20** =		X		=	
Independent Claims		-3** =		X		=	
Multiple Dependent							

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130.00
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 130.00)

## SUBMITTED BY

Name (Print/Type) Jane K. Babin, Ph.D., Esq.

Registration No. 47,224  
(Attorney/Agent)

(Complete if applicable)

Telephone 858-720-2677

Signature

Date 1-6-04

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Patent  
45026.00065.CON1

(formerly 015110.0065.CON1)

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JAN 14 2004

Group Art Unit: 1621

Examiner: Killos, Paul J. OFFICE OF PETITIONS

In re the Application of:

Applicant: Boehm, et al.

Serial No.: 08/479,920

Filed: June 7, 1995

For: COMPOUNDS HAVING  
SELECTIVE ACTIVITY FOR  
RETINOID X RECEPTORS, AND  
MEANS FOR MODULATION OF  
PROCESSES MEDIATED BY  
RETINOID X RECEPTORS

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby petition under 37 C.F.R. § 181 to withdraw the holding of abandonment.

Applicants respectfully submit that the holding of abandonment is in error.

01/13/2004 EFLORES 00000156 502613 08479920

01 FC:1460 130.00 DA

CERTIFICATE OF MAILING  
(37 C.F.R. § 1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450.

Date of Deposit

1-6-04

Janice Crisp

Name of Person Mailing Paper

Signature of Person Mailing Paper

SAN/72082.3

A Notice of Abandonment for this case was mailed on May 6, 1999. In an interview on August 10, 1999, the Examiner recognized that the Notice of Abandonment had been issued in error and agreed to revive the case. That agreement is evidenced in the Interview Summary Record. As is discussed below, it appears that that Interview Summary Record was misplaced within the Patent Office file. Whatever the reason, the Patent Office failed to revive the application, as it had agreed to do in the interview. Since the time of the interview, no event has occurred to provide a basis for holding the application abandoned and no additional Notice of Abandonment has been received by the Applicants. Thus, the holding of abandonment should be withdrawn and the application should be held as pending. Moreover, an Amendment filed August 10, 1999, the same day as the interview, placed the Application in condition for allowance. Thus, Applicants respectfully request that the Application be allowed.

#### Background

On July 28, 1998, Applicants received a Notice of Allowability allowing claims 33-37 and 39-48. Payment of a \$1320.00 issue fee was due on October 28, 1998. On October 14, 1998, Applicants filed a Petition Pursuant to 37 C.F.R. § 1.313(a) to Withdraw Application From Issuance, along with the appropriate petition fee of \$130.00 (copy enclosed). Applicants noted in that Petition that the "claims of the application contain interfering subject matter with the claims of issued U.S. Patent No. 5,466,861 . . ." and further noted that a request for interference would be filed separately. That October 14, 1998 filing was adequate to withdraw the case from issuance as potential

interference provides “good and sufficient reasons why withdrawal of the application from issue is necessary.” See 37 C.F.R. § 1.313(a).

Inspection of the Patent Office file history of the Application (obtained through a third-party service, DigiPat, Arlington VA) showed that Applicants’ Rule 313(a) Petition was not in the file and was not recorded in the application “Contents.” Notwithstanding Applicants’ request for withdrawal from issuance, the application was mistakenly abandoned by the U.S. Patent Office, as evidenced by the “Notice of Abandonment” mailed on May 6, 1999. According to the notice, the application was considered abandoned for failure to pay the issue fee.

Upon receipt of the Notice of Abandonment, Applicants promptly contacted Examiner Killos and confirmed that the abandonment was issued in error. Examiner Killos agreed to correct the mistake and act on the application. On August 10, 1999, Applicants conducted an in-person interview with Examiner Killos, which is memorialized in the Examiner Interview Summary Record (copy enclosed). That Interview Summary Record confirms that the application should not have been abandoned. *See id.* (providing Examiner’s comments: “Case to be revived.”).

Applicants note that this Interview Summary Record appears to have been misfiled by the Patent Office, which may account for the lack of follow-up. When Applicants obtained a copy of the file history, the Interview Summary Record was notably absent from the Contents listing. Upon careful examination of the file, however, the August 10, 1999 Interview Summary Record was found between an Interview Summary Record dated January 8, 1997 (paper No. 10) and an Office Action dated February 24, 1997 (paper No. 11). Perhaps that misfiling of the August 10, 1999 Interview

Summary Record, along with the failure to assign a Paper Number or to catalog the document in the Application Contents, contributed to the inadvertent failure of the Patent Office to recognize that abandonment had been withdrawn.

Also on August 10, 1999, the same day as the interview, Applicants filed an Amendment (copy enclosed). In that Amendment, Applicants cancelled claims containing subject matter that potentially interfered with U.S. Patent Nos. 5,466,861 and 5,837,725 to Dawson, *et al.* The remaining claims, having received a thorough examination on the merits, were thus placed in condition for allowance and a notice to that effect was anticipated by the Applicants.

Applicants thereafter filed a Revocation and Grant of Power of Attorney on July 9, 2001. Then, having not received any correspondence from the Patent Office following the August 10, 1999 Interview and Amendment, Applicants filed a Status Inquiry on November 26, 2001. The Patent Office did not respond to that Status Inquiry. Applicants filed another Revocation and Grant of Power of Attorney on November 1, 2002 and, having not received a response to the Status Inquiry filed November 26, 2001, Applicants inquired as to the status of the application using the Patent Application Information Retrieval (PAIR) system.

Applicants were surprised to learn that as of July 24, 2003, according to the PAIR system, the last four entries in the file history, were:

- (1) Item Number 27 - Mail Notice of Allowance, July 28, 1998;
- (2) Item Number 28 - Abandonment for Failure to Pay Issue Fee, May 6, 1999;

(3) Item Number 29 - Mail Notice of Abandonment from Publications, May 6, 1999;  
and

(4) Item Number 30 - Correspondence Address Change, November 25, 2000.

Thus, the PAIR system and File History for the application do not reflect a number of documents filed by Applicants and/or recorded by the Examiner in this case. Specifically:

(1) the Examiner Interview Summary Record dated August 10, 1999, was found in the Patent Office file, but not in the expected location and not indexed in either the file history contents or the PAIR system;

(2) the Amendment filed by the Applicants on August 10, 1999, is absent from Patent Office records; and

(3) the Petition Pursuant to 37 C.F.R. § 1.313(a) to Withdraw Application From Issuance, filed on October 14, 1998, is neither present in the file history nor indexed in either the file history contents or PAIR system records.

#### Conclusion

Applicants respectfully submit that Patent Office error in misplacing or misfiling the documents listed above mistakenly resulted in failure to withdraw the holding of abandonment. Further, Applicants respectfully submit that the two documents dated August 10, 1999 (*i.e.*, item (1) the Examiner Interview Summary Record, and (2) the Amendment) demonstrate that the Patent Office acknowledged that the application was mistakenly deemed abandoned and agreed to withdraw the holding of abandonment. Since August 10, 1999, no event has occurred that provides a statutory basis for abandonment. Moreover, Applicants have not received a Notice of

Abandonment other than the original Notice mailed May 6, 1999, which the Examiner agreed to withdraw.

Accordingly, Applicants hereby petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment. Applicant provides the required petition fee of \$130.00 under 37 C.F.R. § 1.17(h). If any additional fee is due, the Commissioner is hereby authorized to charge any fee required by this submission to our Deposit Account No. 50-2613.

Respectfully submitted,

PAUL HASTINGS JANOFISKY & WALKER LLP

Dated:

*January 6, 2007*

By:

*Jane K. Babin*  
Jane K. Babin  
Reg. No. 47,224

**PAUL HASTINGS JANOFISKY & WALKER LLP**  
12390 El Camino Real  
San Diego, CA 92130  
Phone: (858) 720-2500  
Fax: (858) 720-2555





The reason why withdrawal of the application is necessary is so that an interference can be declared, since the claims of this application contain interfering subject matter with the claims of issued U.S. Patent No. 5,466,861 (Dawson et al.). Specifically, e.g., claim 48 of this application corresponds nearly identically to claim 13 of Dawson et al., U.S. Patent No. 5,466,861.


A Request For Interference will be filed separately by applicants.

Accompanying this petition is our check for \$130.00 for the fee set forth in 37 CFR § 1.17(i). The Assistant Commissioner is hereby authorized to charge any additional fees which may be required by this petition, or credit any overpayment, to Deposit Account No. 12-2475.

Respectfully submitted,

Dated: October 14, 1998

By:

  
Hope E. Melville  
Reg. No. 34,874

LYON & LYON LLP  
633 West Fifth Street  
Suite 4700  
Los Angeles, California 90071-2066  
(213) 489-1600

Please acknowledge receipt of the following by affixing hereon the Patent and Trademark Office date stamp and returning this card to our office.

Applicant: BOEHM et al.  
Serial No.: 08/479,920  
For: COMPOUNDS HAVING SELECTIVE ACTIVITY FOR  
RETINOID X RECEPTORS, AND MEANS FOR MODULATION  
OF PROCESSES MEDIATED BY RETINOID X RECEPTORS  
Filed: June 7, 1995

Title of Document: PETITION PURSUANT TO 37 CFR § 1.313(a) TO  
WITHDRAW APPLICATION FROM ISSUANCE

Attorney(s): Hope E. Melville  
Docket No.: 214/226  
Enclosure: Check No. 45089 - \$130.00 (petition filing fee)  
Express Mail Label No. EM351173167US Date of Deposit: Oct. 14, 1998

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**LYON & LYON** LLP

633 WEST FIFTH STREET, SUITE 4700

ATTORNEYS - AT - LAW

LOS ANGELES CALIFORNIA 90071-2066

No. 45089

DOCKET NO. 214/226  
SERIAL NO. 08/479,920  
APPLICANT BOEHM ET AL.

EXPLANATION	AMOUNT
PETITION FEE	130.

PAY

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DATE OCTOBER 13, 1998 \$ 130.00

LYON & LYON LLP

*Post-Box*

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**LYON & LYON** LLP  
LOS ANGELES, CALIFORNIA

REMITTANCE ADVICE  
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DEPOSITING CHECK

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PETITION FEE 130.00 (12000)

HEM RE: BOEHM ET AL.  
DOCKET NO. 214/226  
NO. 08/479,920

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Patent No.  
214/226

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

BOEHM, et al.

Serial No.: 08/479,920

Filed: June 7, 1995

For: COMPOUNDS HAVING SELECTIVE  
ACTIVITY FOR RETINOID X RECEPTORS,  
AND MEANS FOR MODULATION OF  
PROCESSES MEDIATED BY RETINOID X  
RECEPTORS

Group Art Unit: 1621

Examiner: Killos, P.

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OFFICE OF PETITIONS

AMENDMENT AND REMARKS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Please amend the above-identified application as follows:

IN THE CLAIMS:

Please cancel claims 45, 46 and 48 without prejudice. Pursuant to the discussion with Examiner Killos at the Examiner's Interview of even date, Applicant will provide a

CERTIFICATE OF FILING  
(37 C.F.R. §1.6(c))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being hand delivered to United States Patent and Trademark Office, Group 1621 at Crystal Mall 1, Arlington, Virginia.

August 10, 1999  
Date of Deposit

Michael Wise

Name of Person Filing Paper

Michael J. Wise  
Signature of Person Filing Paper

Patent No.  
214/226

further response and/or amendment that addresses the Examiner's comments regarding

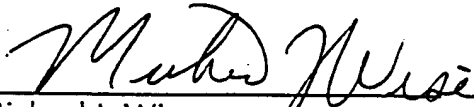
Davies' U.S Patent No. 5,399,586.

Respectfully submitted,

LYON & LYON LLP

Dated: August 10, 1999

By

  
Michael J. Wise  
Registration No. 34,047

633 West Fifth Street, Suite 4700  
Los Angeles, California 90071-2066  
(213) 489-1600



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UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/479920 06/07/95 BOEHM et al

214/226

EXAMINER

Killo, Paul J

ART UNIT

PAPER NUMBER

1621

DATE MAILED:

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):

(1) Michael Wiser (3) S. Elmer

(2) C. Condilio (4)

Date of Interview 10 Aug. 1999

Type: ☐ Telephonic ☒ Personal (copy is given to ☐ applicant ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☐ No. If yes, brief description:

Agreement ☐ was reached with respect to some or all of the claims in question. ☐ was not reached.

Claims discussed:

Identification of prior art discussed:

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Case to be removed will come in with claims to invoke an interference with Davis or around claim & be allowable

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☐ 1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph below has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

☐ 2. Since the examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the substance of the interview unless box 1 above is also checked.

Examiner's Signature

PTOL-413 (REV. 2-93)

ORIGINAL FOR INSERTION IN RIGHT HAND FLAP OF FILE WRAPPER